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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,333	04/04/2001	Toshio Yagihashi	Q63916	1819

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
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Washington, DC 20037

EXAMINER
BACKER, FIRMIN

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,333

Applicant(s)

YAGIHASHI ET AL.

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Response to Request for Reconsideration

1. This is in response to a request for reconsideration file April 8th, 2005. Claims 1-27 are being reconsidered in this action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. (U.S. Patent No. 2004/0010724) in view of Yamada (U.S. Patent No. 6,336,100).

4. As per claims 1, 6, 11, 16, 20 and 24, Brown et al. teaches an inventive concept using such personal authentication information for authenticating a member as member identification information and a password, comprising registration unit for registering physical characteristics of each the member in advance; and processing unit responsive to application of physical characteristics by a purchaser for comparing the applied physical characteristic information and the physical characteristic information registered at the registration unit to conduct authentication and determining whether connection is allowed or not according to authentication results (*see abstract, paragraphs 0023, 0024, 0032, claims 1, 15, 17, 21, 23*). Brown et al. fails to teach an

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inventive concept of a mail-order system for members by which a member purchases commodities by accessing a mail-order site side server through a network. However, Yamada teaches an inventive concept of a mail-order system for members by which a member purchases commodities by accessing a mail-order site side server through a network (*see fig 1-3, column 1 lines 19-45*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brown et al's inventive concept to include Yamada concept of a mail-order system for members by which a member purchases commodities by accessing a mail-order site side server through a network because this would have provided a system for shopping wherein customer can order merchandise and designate addresses or places where the good or merchandise can be delivered.

5. As per claims 2, 7, 12, Brown et al. teaches an inventive concept further comprising a server for members for authenticating the member, wherein the registration unit and the processing unit are provided at the server for members (*see abstract, paragraphs 0023, 0024, 0032, claims 1, 15, 17, 21, 23*).

6. As per claims 3, 8, 13, 17, 21 and 25, Brown et al. teaches an inventive concept further comprising unit for enciphering the personal authentication information and the physical characteristic information so as to be in correlation with each other and registering the enciphered information at the registration unit, and reading and decoding the information enciphered (*see abstract, paragraphs 0023, 0024, 0032, claims 1, 15, 17, 21, 23*).

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7. As per claims 4, 9, 14, 18, 22 and 26, Brown et al. teaches an inventive concept further comprising unit for enciphering the personal authentication information and the physical characteristic information so as to be in correlation with each other and registering the enciphered information at the registration unit, and reading and decoding the information enciphered, wherein the decoding unit decodes the personal authentication information when results of authentication of a purchaser's physical characteristics applied at the purchase of a commodity and the registered physical characteristics coincide with each other (*see abstract, paragraphs 0023, 0024, 0032, claims 1, 15, 17, 21, 23*).

8. As per claims 5, 10, 15, 19, 23 and 27, Brown et al. teaches an inventive concept further comprising unit for enciphering the personal authentication information and the physical characteristic information so as to be in correlation with each other and registering the enciphered information at the registration unit, and reading and decoding the information enciphered, wherein the decoding unit decodes the personal authentication information when results of authentication of a purchaser's physical characteristics applied at the purchase of a commodity and the registered physical characteristics coincide with each other, and the processing unit transmits the personal authentication information decoded to the mail-order site side server (*see abstract, paragraphs 0023, 0024, 0032, claims 1, 15, 17, 21, 23*).

Response to Arguments

9. Applicant's arguments filed April 8th, 2005 have been fully considered but they are not persuasive.

a. Applicant argues the prior art fail to teach an inventive concept of physical characteristics be register or processed such as finger print to provide identification of a customer. Examiner respectfully disagrees with Applicant characterization of the prior art. Brown teach an inventive concept wherein a server responds to requests to query the registration status of a user with a command to capture the appropriate biometric or password. A user can have multiple biometrics registered (fingerprint, voice print, facial shape, etc.), with one biometric designated as primary. The server also maintains a database of Biometric Identifier Records (BIRs) for a plurality of registered users. Each BIR contains biometric information for a user, preferably in accordance with the HA-API specification. Each registered BIR is associated in the database with the corresponding user's userID and password. Furthermore the Server supports multiple biometric types (e.g. fingerprint, voice print, facial shape, etc.) and multiple vendor technologies for each biometric type. A system administrator can set the primary biometric type and technology for each user.

b. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning.

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But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

c. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination is proper since the inventive concepts in the prior art are in the same environment.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

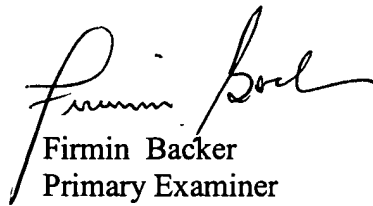
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (571) 272-6703. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Firmin Backer
Primary Examiner
Art Unit 3621

June 27, 2005